

## REMARKS

Favorable reconsideration and withdrawal of the rejection set forth in the final Office Action dated February 3, 2009, are respectfully requested in view of the foregoing amendments and the following remarks.

### *Status of the Claims*

Claims 18-31 are pending, with Claims 18, 21, 24, 28, and 31 being independent. Claims 18, 19, 21, 22, 24, 25, 28, and 29 have been amended. Claim 31 has been added. Support for the new claim and claim changes can be found in the original disclosure, for example, in Figures 1 and 2 and the accompanying disclosure, and therefore no new matter has been added.

### *Claim Rejections*

Claims 18-30 were rejected for obviousness-type double patenting over Claims 27-29 and 36-48 of U.S. Patent No. 6,630,954 (Okada), issued on the parent of this application. In addition, Claims 18-30 are rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,473,370 (Moronaga et al.).

In response, while not conceding the propriety of the rejections, being Claims 18, 19, 21, 22, 24, 25, 28, and 29 have been amended. Applicant submits that as amended, independent Claims 18, 21, 24, and 28 are allowable for the following reasons.

Independent Claim 18 relates to an electronic apparatus for use with an image pickup device, comprising a memory control device which controls recording to record on a memory an image file corresponding to an image picked up by the image pickup device,

and data. Claim 18 also recites a control device that controls transfer of the image file from the memory to a different storing area and rewrites the data.

Claim 18 has been amended to recite that the memory control device controls recording to record on a memory past-transfer-history data which indicates whether the image file that is currently held in the memory has been ever transferred in the past from the memory to a different storing area or not. Claim 18 has also been amended to recite that the control device controls transfer of the image file from the memory to a different storing area and rewrites the past-transfer-history data in response to the image file being transferred.

#### A. Obviousness-type double patenting rejection

Turning to the obviousness-type double patenting rejection, MPEP § 804 states that “the analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination”. And to reject a claim under 35 U.S.C. 103, MPEP § 706.02(j) requires that the Office Action provide:

A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Further, MPEP § 2142 states that:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

But here, the Office Action merely states, in rejecting Claim 18, that "Claims 18-20 are obvious variants and encompassed by claims 36-38 and 43-45 of Patent'954".

Applicant submits that this rationale is precisely the type of conclusory statement the Federal Circuit warned cannot support a prima facie case of obviousness. Moreover, Applicant submits that such a cursory explanation of the finding of a prima facie case of obviousness does not satisfy the provisions of either MPEP § 706.02(j) or MPEP § 804, as noted above. Further, Claims 27-29 and 36-48 of the Okada patent are not understood to disclose or suggest a control device that rewrites the past-transfer-history data in response to the image file being transferred, as recited by amended Claim 18. As a result, amended Claim 18 recites at least one feature not recited in Claims 27-29 and 36-48 of the Okada patent. The Office Action never addresses this point or explains why it would be obvious to add this feature to Claims 27-29 or 36-48 of the Okada patent. For all of these reasons, Applicant submits that the Office has not yet established a prima facie case of obviousness-type double patenting over Claims 27-29 or 36-48 of the Okada patent. Therefore, Applicant respectfully requests that the rejection of amended Claim 18 be withdrawn.

B. Rejection Under 35 U.S.C § 103

As noted above, amended Claim 18 recites that a) the memory control device controls recording to record on a memory past-transfer-history data which indicates whether the image file that is currently held in the memory has been ever transferred in the past from the memory to a different storing area or not, and b) the control device controls transfer of the image file from the memory to a different storing area and rewrites the past-transfer-history data in response to the image file being transferred.

In contrast, the citation to Moronaga et al. is not understood to disclose or suggest a memory control device that controls recording to record on a memory past-transfer-history data which indicates whether the image file that is currently held in the memory has been ever transferred in the past from the memory to a different storing area or not, as recited by amended Claim 18. In addition, this citation is not understood to disclose or suggest a control device that controls transfer of the image file from the memory to a different storing area and rewrites the past-transfer-history data in response to the image file being transferred, as also recited by amended Claim 18.

1. Figures 1 and 3a -3c of the Moronaga et al. citation

Figures 1 and 3a -3c of the citation to Moronaga et al. are understood to store image data in RAM 28 or 31, but are not understood to disclose or suggest 1) the transfer of the image data from one memory to the other, or 2) the storing of data identifying such a transfer. More specifically, this embodiment of the citation to Moronaga et al. is understood to disclose that image data generated by the CCD 38 passes through an interface 42 "to be stored in the internal RAM 28 or the external RAM 31, depending upon

the setting of the memory selecting switch 13" (col. 9, lines 62 through col. 10, line 9). In addition, if the memory cartridge 29 is loaded in the camera 10:

a) visual indications "CA 12" and "IN12" on the display are understood to indicate that the number of photographable frames in the RAM 31 and the RAM 29, respectively, is 12,

b) the numbers appearing below "CA 12" and "IN12" are understood to indicate the number of shot frames already stored in the RAM 31 and the RAM 29, respectively;

c) when a triangle appears to the left of this already-stored-frame number below "CA 12", this is understood to indicate that when the next photograph is generated, the first frame of the image data representing the image of the photographed subject will be recorded in the RAM 28; and

d) when the triangle appears to the left of this already-stored-frame number below "IN 12", this are understood to indicate that when the next photograph is generated, the first frame of the image data representing the image of the photographed subject will be recorded in the RAM 31 (col. 10, line 44 through col. 11, 35).

Thus, these portion of the Moronaga et al. citation are understood to disclose the storing of image data in either one of two memories, and the displaying of visual indications of the capacity of each memory (the number displayed adjacent "CA" and the number displayed adjacent "IN"), the number of frames stored in each memory (the number displayed below "CA" and the number displayed below "IN), and which memory will store the next photographed frame (as shown by the position of the displayed triangle) . But, there does not appear to be any disclosure of storing data indicating whether an image file

currently held on a memory has ever been transferred from the memory to a different storing area, as recited by Claim 18.

2. Figures 7-9 of the Moronaga et al. citation

Section 226 of Figure 8 is understood to show the display of the direction in which image data is transferred between the internal memory 213 and the external memory 231, in response to pressing a mode selection button 233.

More specifically, this figure is understood to show, according to column 22, line 33 - column 23, line 5, in the copy mode:

a) the memory from which a frame is to be transferred is selected by the select button 234, a representation of the selected memory is lit up on the display panel 221, and the direction of transfer between the two memories is indicated by the lighting up of either a rightward directed arrow, indicating transfer from the internal memory 213 to the external memory 231, or the lighting up of a leftward directed arrow, indicating transfer from the external memory 231 to the internal memory 213, and

b) the frame to be transferred from the selected memory is selected by pressing the up button 238 or the down button 237, and the frame number of the selected frame is displayed in the display section 224 or 225.

In the recording mode, as is understood to be discussed at column 22, lines 7-19, the remaining number of frames that can be recorded in each memory is displayed in areas 224 and 226, and an underline segment 224a or 225a is lit to indicate the memory which will store the next frame that is recorded.

And in the playback mode, as is understood to be discussed at column 22, lines 20-32, the frame number being played back is shown in sections 225 and/or 225, and the memory that stores the played-back frame is highlighted by lighting up either the segment 224a or 224b, depending on whether the selected memory is the memory 213 or 231.

In other words, as is understood to be shown in these figures, the Moronaga et al. device displays information about a photographed frame indicative of the present (in the playback mode, the display 211 displays the frame number and the memory currently storing a particular frame that is being played back), and the future (in the copy mode, the frame number of a frame that will be copied in the future (once the shutter-release button 236 is pressed) in section 224 or 225, depending on whether that frame is stored in the memory 213 or 231). There does not appear to be any disclosure of the recording or displaying of data indicating that an image file has been transferred from one memory to a different storing area in the past.

Accordingly, amended Claim 18 is understood to recite at least one feature not disclosed or suggested by the different embodiments of the Moronaga et al. citation. Therefore, Applicant submits that the Office has not yet established a prima facie case of obviousness against amended Claim 18. For this reason, Applicant respectfully requests that the rejection of Claim 18 be withdrawn. And because independent Claims 21, 24, and 28 have been amended in a similar manner, they are submitted to be allowable for similar reasons. Therefore, Applicant respectfully requests that the rejection of Claims 21, 24, and 28 be withdrawn.

*New Claim 31*

New Claim 31 relates to an electronic apparatus for use with an image pickup device. The apparatus comprises a memory control device, a control device, an erasing switch, and a reading device.

The memory control device controls recording to record on a memory an image file corresponding to an image picked up by the image pickup device, and past-transfer-history data which indicates whether the image file that is currently held in the memory has been ever transferred in the past from the memory to a different storing area or not.

The control device controls transfer of the image file from the memory to a different storing area and rewrites the past-transfer-history data in response to the image file being transferred.

The erasing switch is adapted to be turned on and off, wherein the image file is erasable by the electronic apparatus in response to the turning on of the erasing switch.

The reading device reads the data indicating whether the image file that is currently held in the memory has been ever transferred in response to turning the erasing switch on and before the electronic apparatus erases the image file.

In contrast, Claims 27- 29 and 36-48 of U.S. Patent No. 6,630,954 (Okada), and Moronaga et al. citation are not understood to disclose or suggest the memory control device, the control device, the erasing switch, or the reading device recited by Claim 31. Therefore, Applicant submits that Claim 31 is allowable over these citations.



### *Dependent Claims*

The dependent claims are also submitted to be patentable, due to their dependency from the independent base claims, as well as due to additional features that are recited. Individual consideration of the dependent claims is respectfully solicited.

### *Conclusion*

In view of the foregoing amendments and remarks, the application is now in allowable form. Therefore early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

/Gary M. Jacobs/

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Gary M. Jacobs  
Attorney for Applicant  
Registration No. 28,861

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3801  
Facsimile: (212) 218-2200  
GMJ/klm

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